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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,619	12/29/2000	Jesse Salb	04646.P003D	1327

7590

08/28/2002

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 08/28/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/752,619

Applicant(s)

SALB, JESSE

Examin r

D. L. Jones

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1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2000 and 28 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 65-79 is/are pending in the application.
- 4a) Of the above claim(s) 71-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-70 and 76-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the following:
  - a. Paper No. 2, filed 12/29/00, wherein the specification was amended and claims 1-64 and 80-86 were canceled; and
  - b. Paper No. 4, filed 5/28/02, wherein claim 77 was amended.

**Note:** Claims 65-79 are pending.

## RESPONSE TO APPLICANT'S ELECTION

2. Applicant's election with traverse of Group I (claims 65-70 and 76-79) wherein S = pyranose in Paper No. 4, filed 5/28/02, is acknowledged. In addition, the Examiner acknowledges the election of the species (*for search purposes*) wherein S = pyranose; X = an substituted aryl in which at least one atom is substituted by a radio-opacifying atom of an element with atomic number of Z = 35 to Z = 74; L = unsubstituted/substituted arylamido bonded to the S and X moieties. The traversal is on the ground that Applicant believes the restriction requirement unduly parsed the claims by requiring an election as to the species in connection with S, X, and L moieties.

Applicant's arguments are found non-persuasive because when one reviews Applicant's general formula (e.g., see claim 65), one is able to see there is no common core. Thus, the inventions are distinct. In addition, review of the claims and the groups set forth in the restriction requirement illustrates that the searching of one group of claims would neither anticipate nor render obvious the other groups. Hence, separate

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searching of each group would be necessary. Hence, the restriction requirement is still deemed proper and is therefore made FINAL.

### **WITHDRAWN CLAIMS**

3. Claims 71-75 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

### **DOUBLE PATENTING REJECTIONS**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 76-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33, 40, 41, 48, 63, and 64 of U.S. Patent No. 6,226,352 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention encompass the patented invention. In particular, both sets of claims read on methods of in vivo imaging. The inventions differ in that the patented invention is limited to X-ray analysis.

6. Claims 65-70 and 76-79 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 26-33, 37, and 42 of copending Application No. 09/809,870. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compounds of formula X-L-S and uses thereof. The claims differ from those of 09/809,870 in that the X variable is a carbon compound substituted with at least one atom having a K-absorption edge of about 13 keV to about 90 keV and/or the global logP value of the composition is greater than about 0.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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7. Claims 76-79 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 37, 56, 81, 84, 86, 88, and 89 of copending Application No. 09/810,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of imaging comprising compounds of formula X-L-S. The claims differ from those of 09/810,130 in that in the instant invention the method claims specifically read on imaging while the claims of 09/810,130 require imaging techniques in order to obtain the data.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### **COMMENTS/NOTES**


8. It should be noted that no prior art has been cited to reject the claims of Group I. Thus, the claims are distinguished over the prior art because the prior art neither anticipates nor renders obvious compounds and uses thereof having the general formula X-L-S wherein S = pyranose and L and X are as defined in claim 65. The closest art is Applicant's own work, which is cited in the double patenting rejections above.

**Note:** Applicant is respectfully requested to cancel all subject matter not directed to the elected invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



D. L. Jones  
Primary Examiner  
Art Unit 1616

August 21, 2002